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SEP -2 2003

Paper No. 24

In re Application of :
Patrick H. Wnek : DECISION ON PETITION
Application No. 09/764,718 :
Filed: January 18, 2001 :
Attorney Docket No. 5887.00 :

This is a decision on the petition filed on August 7, 2003 by which petitioner requests withdrawal of the examiner's holding that this application stands abandoned as a result of the dismissal of petitioner's appeal, no claims standing allowed after that dismissal. No fee is required for this petition.

The petition is granted.

A review of the record shows that after filing a notice of appeal on January 8, 2003, petitioner timely filed an appeal brief. The examiner held the brief to be defective for failure to comply with the requirements of 37 CFR 1.192(c)(6)-(9), specifically identifying the reasons for this holding. The examiner's letter notifying petitioner of this circumstance was mailed on June 3, 2003, and the period for reply thereto was set to expire one month therefrom, and was stated to be subject to the extension of time provisions of 37 CFR 1.136. See paper No. 18. See also 37 CFR 1.192(d). See also the discussion regarding the response period as set forth *infra*.

The record further shows that petitioner filed a reply to paper No. 18, and included therewith a corrected appeal brief. This reply was timely filed on June 23, 2003, and was entered in the record as paper No. 19. The examiner thereafter held the corrected appeal brief to be defective "for at least the reason that applicant submits a revised brief which is not compliant with 37 CFR 1.192(C) (*sic*, "1.192(c)") for the same reasoning has (*sic*, "as") presented in the Notification of Non-compliance mailed June 3, 2003 because the arguments section is not separated by separate headings for each issue on appeal." The examiner also pointed out that the revised appeal brief lacked an argument in support of the patentability of each claim stated by petitioner to not stand or fall with the other claims grouped together in a single ground of rejection. As a result of the failure of petitioner to supply an acceptable corrected brief, the examiner dismissed the appeal and held the application to have become abandoned. See paper Nos. 20 and 21.

The examiner's holding of abandonment was in error, because at the time that the examiner promulgated paper Nos. 20 and 21, the application was not abandoned. Paper No. 18, the examiner's original notice that the appeal brief filed on March 17, 2003 was informal under 37 CFR 1.192(c)(6)-(9) set a **time period** for response in accordance with 37 CFR 1.192(d). That period was stated to be:

"the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH** or **THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken." (Emphasis in the original.)

Paper No. 18 also stated:


"EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136."
(Emphasis in the original.)

In addition, 37 CFR 1.191(d) reads, *inter alia*, "The time periods set forth in §§ 1.191 and 1.192 are subject to the provisions of § 1.136 for patent applications"

Applying these principles, it is clear that the application was pending due to the timely filing of paper No. 19, the corrected appeal brief. The longest period of time to be selected from the options provided by paper No. 18, the notice to petitioner that the corrected appeal brief was defective, would have been one month from June 23, 2003. Therefore, the Notice of Abandonment was prematurely mailed. Further, petitioner has attached three copies of another corrected appeal brief to the petition, and the application also contains an authorization to charge any additional 37 CFR 1.17 fees to Deposit Account 04-1415. Therefore, this corrected appeal brief is timely filed since it has been received prior to November 23, 2003 with a constructive petition for a one month extension of time.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner to charge Deposit Account 04-1415 in the amount of \$110.00 for a one month extension of time. Thereafter, the application will be forwarded to the examiner for action on the appeal brief filed on August 7, 2003.

PETITION GRANTED.


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Examining Groups 3710 and 3720

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